

REMARKS

In the Office Action, the Examiner rejected claims 1-20. By this paper, Applicant has amended claims 1-14, 19, and 20 for clarification of certain features and to expedite allowance of the present application. These amendments do not add any new matter. Upon entry of these amendments, claims 1-20 will remain pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, Applicant respectfully requests reconsideration and allowance of all pending claims.

Claim Rejections under 35. U.S.C. § 102

The Examiner rejected claims 1-4, 13, 19, and 20 under 35 U.S.C. § 102(b) as anticipated by Reynolds (U.S. Patent No. 3,825,335). Applicant respectfully submits that amended independent claims 1, 13, 19, and 20 recite features not disclosed in the cited reference.

Legal Precedent and Guidelines

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, Applicant needs only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the identical invention “in as complete detail as contained in the ... claim” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Claim Features of Independent Claims Omitted from Cited Reference

Turning to the claims, amended independent claims 1 and 13 recite, *inter alia*, “A physiological sensor ... to enable measurement of a physiological parameter.” (Emphasis added). Similarly, amended independent claim 19 recites, *inter alia*, “A method of manufacturing a physiological sensor.” (Emphasis added). Amended independent claim 20 recites, *inter alia*, “A method of measuring a physiological parameter.” (Emphasis added).

Applicant notes that the Reynolds reference relates to a variable lighting system for photography. *See* Reynolds, Abstract. Accordingly, nothing in the Reynolds reference teaches or discloses a physiological sensor or means for measuring a physiological parameter. On the contrary, the cited reference merely includes colored lights for illuminating a scene for color photography. *See* Reynolds, col. 1, lines 7-10. For at least these reasons, the Reynolds reference cannot anticipate independent claims 1, 13, 19, or 20, or their dependent claims.

Furthermore, amended independent claim 19 recites, *inter alia*, “providing light detection optics configured to detect attenuation of the spatially homogenized electromagnetic energy emitted from the outlet.” Amended independent claim 20 similarly recites, *inter alia*, “detecting attenuation of the output spatially homogenized electromagnetic energy at a tissue location.” As discussed above, the Reynolds reference discloses a lighting system for photography. *See* Reynolds, col. 1, lines 7-10. Accordingly, the cited reference does not disclose detecting attenuation of the electromagnetic energy. The Reynolds reference therefore does not appear to anticipate independent claims 19 or 20. In view of these deficiencies, Applicant respectfully requests withdrawal of the rejection of claim 1-4, 13, 19, and 20 under 35 U.S.C. § 102.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 5-9, 11-16, and 18 under 35 U.S.C. § 103(a) as obvious over Vari et al. (U.S. Patent No. 5,701,902) in view of Reynolds. In addition, the Examiner rejected claims 10 and 17 under 35 U.S.C. § 103(a) as obvious over Vari and Reynolds in view

of Jeffcoat et al. (U.S. Patent No. 5,036,853). Applicant respectfully traverses the combination of the cited references.

Legal Precedent and Guidelines

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). In making a rejection under 35 U.S.C. § 103, it is improper for the Examiner to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. In addition, there must be some reason to combine references other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The Federal Circuit has warned that the Examiner must not, “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)).

Furthermore, in addressing obviousness determinations under 35 U.S.C. § 103, the Supreme Court in *KSR International Co. v. Teleflex Inc.*, No. 04-1350 (April 30, 2007), reaffirmed many of its precedents relating to obviousness including its holding in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). In *KSR*, the Court also reaffirmed that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.* at 14. In this regard, the *KSR* court stated that “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does ... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already

known.” *Id.* at 14-15. In *KSR*, the court noted that the demonstration of a teaching, suggestion, or motivation to combine provides a “helpful insight” in determining whether claimed subject matter is obvious. *KSR, slip op.* at 14.

The *KSR* court also did not diminish the requirement for objective evidence of obviousness. *Id.* at 14 (“To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) (“[R]jections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”); see also, *In re Lee*, 61 U.S.P.Q.2d 1430, 1436 (Fed. Cir. 2002) (holding that the factual inquiry whether to combine references must be thorough and searching, and that it must be based on objective evidence of record).

Improper Combination

The Examiner has improperly combined the primary Vari and Reynolds references which teach away from one another. The Vari reference specifically teaches random dispersion of optical fiber bundles 48-54. See Vari et al., col. 5, lines 24-27. In contrast, the Reynolds reference specifically discloses ordered distribution of optical fibers carrying red, green, and blue light. See Reynolds, col. 6, lines 43-48. As a random configuration is the opposite of an ordered configuration, these references clearly teach away from one another. Furthermore, the Examiner has not provided an objective motivation for combination of a reference relating to photography (i.e., Reynolds) with a reference relating to the very different field of spectroscopic burn injury evaluation (i.e., Vari). For at least this reason, the proposed combination is improper and must be withdrawn.

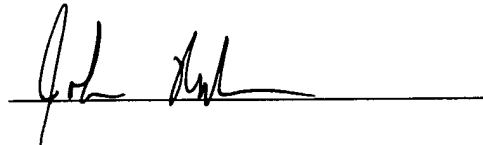
In addition, the Jeffcoat reference, combined with either the Vari reference or the Reynolds reference, does not obviate the deficiencies of either reference with regard to disclosing all elements of the independent claims, as discussed above and in the Response to Office Action mailed January 23, 2007. In view of these deficiencies, among others, Applicant respectfully requests withdrawal of the rejection of claims 5-18 under 35 U.S.C. § 103.

Conclusion

In view of the remarks set forth above, Applicant respectfully requests reconsideration of the Examiner's rejections and allowance of all pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: January 18, 2008

A handwritten signature in black ink, appearing to read "John M. Rariden", is written over a horizontal line.

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